



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

HC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,607	08/10/2001	Steven L. Forte	FL 12-047	7534

21567 7590 12/12/2002

WELLS ST. JOHN ROBERTS GREGORY & MATKIN P.S.  
601 W. FIRST AVENUE  
SUITE 1300  
SPOKANE, WA 99201-3828

EXAMINER

LAYNO, BENJAMIN

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/927,607

Applicant(s)

FORTE ET AL. *Ch*

Examiner

Benjamin H. Layno

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Reissue Applications*

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,934,998 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

3. The recitation "Broadening claims needed include those having more emphasis on the special round described in the Patent. This was not adequately claimed in the Patent as originally issued and thus the original Patent was in error for not claiming subject matter for which patent protection is properly granted", is not an appropriate error for which a reissue can be based. In identifying the error it is sufficient that the reissue oath/declaration identify a single word, phrase or expression in the specification or in an original claim, and **how it renders the original patent wholly or partially**

**inoperative or invalid.** This is not recited in the declaration. See MPEP 1414, pp. 1400-22 to 1400-23.

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The declaration does not include a declarant's warning against **perjury** and jeopardy to the validity of the patent.

The oath or declaration does not identify the foreign application which foreign priority is being claimed by specifying the application number, country, day, month and year of its filing as required by 37 CFR 1.63(c). The original patent contains a claim for foreign priority, such a claim must be repeated in the reissue application in order to retain priority to the earlier effective filing date. MPEP 1417.

### ***Rejection Based On Recapture***

5. Claims rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the

Art Unit: 3711

narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the original patent application 09/913,723, now Patent No. 5,934,998, in response to a 102(e) rejection, the Applicant's filed an amendment dated 12/28/98. In the amendment the Applicant canceled all existing original claims 1-76 and added new claims 77-84 (now Patent claims 1-8) to obviate the 102(e) rejection. The Applicant argued that new claim 77 patentably defines over the art of record. The Applicant indicated that the new limitations "player jackpot tally event display and the dealer bust event display" and "the simultaneous incremented count of the player jackpot tally event counter and the dealer bust event counter" in claim 77 are not taught in any of the art of record. The Examiner agreed and made a note of it in the Examiner's Reasons for Allowance, paper no. 16. However, these limitations are **not** present in the reissue claims. Thus, the omission of these limitations provides a broadening aspect to the reissue claims relating to surrendered subject matter.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 9-11, 17-20, 23-27, 33-36, 39-43, 49-52, 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Breeding 892'.

The patent to Breeding discloses a method of playing a casino card game comprising conducting play of a first casino card game according to first game rules, see col. 5, line 54 to col. 6, line 53 and see flow diagram in Fig. 2, steps 40-56. A special round threshold event occurs when the highest one hundred winning hands are registered by participating players over a given time period, this acts as a trigger for conducting play of at least one special round game (tournament play to win a super jackpot), col. 7, lines 10-13. Breeding recites that the second game or special round game may be a betting game different from the first casino card game, and thus is conducted according to special round rules, col. 7, lines 18-21. A special round bonus award (super jackpot) is paid out if the rules of the special round game are met during the special round game, see table, col. 7, lines 1-8. The players that post the highest one hundred winning hands are eligible to play the special round game, thus, the special round game involves play of multiple players and a dealer.

In regard to claim 41, Breeding discloses a video embodiment of the casino card game, col. 13, lines 27-31.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 13, 15, 28, 29, 31, 44, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding 892' as applied to claims 9, 25, 41 above, and further in view of Green.

The patent to Green discloses a method for playing a casino card game wherein the object of Green's game is for a player to receive a plurality of consecutive events (winning hands), in which case the player is awarded a jackpot bonus, col. 10, lines 23-28. In view of such teaching, it would have been obvious to modify Breeding's special round threshold event by requiring that a player receive a plurality of consecutive events (winning hands) to qualify for the special round game. This modification would have provided another opportunity for players to win the super jackpot, thus making the game more exciting to play.

10. Claims 14, 16, 30, 32, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding 892' in view of Green as applied to claims 9, 25, 41 above, and further in view of Griffiths.

The patent to Griffiths discloses a method for playing a casino card game wherein the object of Griffith's game is to wager on whether the dealer's hand will win or not. In view of such teaching, it would have been obvious to modify Breeding's special round threshold event by requiring that the dealer or the player and the dealer receive a plurality of events (winning hands or bust). This modification would have given players the alternative of betting on the dealer's hand, thus adding variety to Breeding's game.

Art Unit: 3711

11. Claims 21, 22, 37, 38, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breeding 892' as applied to claims 9, 25, 41 above, and further in view of Celona.

The patent to Celona discloses a method of playing a progressive jackpot casino game comprising a plurality of linked gaming machines. When a progressive jackpot-winning outcome occurs at one of the linked machines, the winning machine signals a controller which then announces the win. Eligible players at the other linked machines that did not get the progressive jackpot-winning outcome share a portion of the jackpot, see abstract. In view of such teaching, it would have been obvious to link Breeding's video game machines, and when a special round player wins during the special round game, the special round bonus award would have been divided among the other special round players. This modification would have kept Breeding's game interesting to all the players.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 21-23, 37-39, and 53-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21 and 22 are identical. Claims 37 and 38 are identical. Claims 53 and 54 are identical. This is indefinite. Correction is required.

Claims 23, 39 and 55 are all incomplete. Correction is required.



Art Unit: 3711

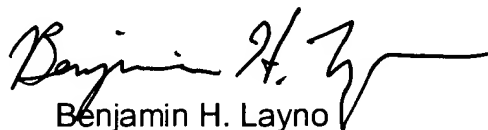
***Allowable Subject Matter***

14. Claims 1-8 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl  
December 9, 2002